

PATENT CO-OPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

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PCT

WRITTEN OPINION

(PCT Rule 66)

Date of mailing
(day/month/year)

14. 12. 98

Applicant's or agent's file reference
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REPLY DUE

within **2 month(s)**
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International application no.

PCT/US97/22136

International filing date (day/month/year)

11/12/1997

Priority date (day/month/year)

13/12/1996

International Patent Classification (IPC) or both national classification and IPC

G07F19/00

Applicant

CERTCO, LLC et al.

1. This written opinion is the **second** drawn up by this International Preliminary Examining Authority.

2. This report contains indications relating to the following items:

- I ☒ Basis of the opinion
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☒ Certain defects in the international application
- VIII ☐ Certain observations on the international application

3. The applicant is hereby **invited to reply** to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also: For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and / or arguments, see Rule 66.4bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: **13/04/1999**

Name and mailing address of the international preliminary examining authority



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WRITTEN OPINION

International application No. PCT/US97/22136

I. Basis of the opinion

1. This opinion has been drawn on the basis of (*substitute sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed"*):

Description, pages:

1-103	as originally filed		
16a-16c	as received on	23/11/1998 with letter of	18/11/1998

Claims, No.:

1-30	as received on	23/11/1998 with letter of	18/11/1998
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Drawings, sheets:

1/12-12/12	as originally filed
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2. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

3. This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)):

4. Additional observations, if necessary:

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims
Inventive step (IS)	Claims
Industrial applicability (IA)	Claims

2. Citations and explanations

see separate sheet

VII. Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

concerning section V (reasoned statement)

- 1). The following documents (D) are referred to in this communication; the numbering will be adhered to in the rest of the procedure:

D1: M. Bellare et al.: "iKP- A Family of Secure Electronic Payment Protocols"; Proceedings of the USENIX Workshop on Electronic Commerce; 11 July 1995; pages 89-106; XP000579445.

D2: WO-A-96/21192

The closest prior art available is referred to in documents D1 and D2.

D1, see in particular the paragraph bridging pages 89 and 90, contains a general discussion on secure electronic payment protocols, between relying parties (customer - merchant - acquirer [= gateway to existing clearing/authorization network]). All parties are previously provided (probably from a certification authority) with certificates, including Ks/Kp.

D2 (see the abstract) concerns the electronic sale of goods. On receiving a request from a buyer, the clearinghouse makes a determination of the risk classification and transfers the payment amount (minus discount fee, depending on that classification) to the seller's account, and an invoice, for the purchase price, to the buyer.

- 2). The originally filed set of claims 1-61 was replaced by an amended set of claims 1-30. Considering claims 1, 8 and 14 of the remaining four independent claims of said new claim's set it appears that the objection raised in the preceding Written Opinion in respect of Rule 13.1 PCT has been overcome.

However, the examiner notes that the wording of the present independent claims 1, 8, 14 and 21 (erroneously referred to by the Applicant as claims 1, 8, 13 and 20) can not exactly be identified in any of the originally filed independent claims.

- 2.1). Present independent system claim 1 shows similarities with former independent claim 23 and differs therefrom by some generalizations (features of the original claim or parts thereof were dropped), eg.
"upon receipt of a request message from relying parties, said request message including transaction-based information");
and by amendments, eg.
"certification authority" has been replaced by "authority",
"attestations to subscribers" has been changed to "subscriber assurance",
"authorization message" has been replaced by "transaction assurance", and
"being based on the information provided by the certification authority and on the transaction-based information provided by the relying parties" now reads "**at least** on the subscriber attribute assurance".
- 2.2). Present independent claim 8 appears to correspond, in terms of a method, with the content of present claim 1.
The objection raised to claim 1 correspondingly apply in respect of claim 8.

In particular the vague expression "based at least on" in claims 1 and 8 does not appear to have a sound basis in the original disclosure and also renders unclear these claims.
- 2.3). Present independent method claims 14 and 21 probably originating from former independent method claims 34 and 29, respectively show comparable modifications.
- 3). Where replacement pages are filed and it is not obvious how the text has been amended, the Applicant should explain from which points of the original application documents the amendments are derived.
In order to facilitate the examination of the conformity of the amended application with the requirements of Article 34(2)(b) PCT, the applicant is requested to clearly identify the amendments carried out, no matter whether they concern amendments by addition, replacement or deletion, and to indicate the passages of the application as filed on which these amendments are based (see also Rule 66.8(a) PCT).

If the applicant regards it as appropriate these indications could be submitted in handwritten form on a copy of the relevant parts of the application as filed.

Amendments to the content of an application may be allowed during the examining procedure if they do not introduce subject-matter which goes beyond the content of the application as filed (Article 34 (2) (b) PCT).

Rewording of a claim's feature, eg. the use of an allegedly synonymous expression can extend the scope of a claim and requires a clear basis in the application as filed.

Thus, amendments extending the scope should be removed from the claims, and any information the applicant may wish to submit concerning the subject-matter of the invention, for example further details of its advantages or of the problem it solves, and for which there is no basis in the application as filed, should be confined to the letter of reply rather than be incorporated into the application, Article 34(2)(b) PCT.

- 4). Independent claims 1 and 8, if redrafted and completed to include the features originally disclosed to be essential for the invention (cf. eg. originally filed claim 23) would appear to meet the requirements of the PCT.
- 5). The subject-matter of independent claim 21 is not, in fact, so linked with the method defined in claim 14, as to form a single general inventive concept (Rule 13.1 PCT). While claim 14 describes the steps of reception of a transaction representing electronic signal, and of subsequent creation of a reliance request message to be sent to a reliance server requesting a transactional assurance, claim 21 deals with steps of receiving (by the reliance server) and evaluating of said reliance request message for determining of whether transactional assurance based on said reliance request message is available.
Claim 21 apparently describes how the reliance server's request for a transactional assurance for the aspect of the transaction upon which the relying party intends to rely may be dealt with and thus relates to an embodiment, ie. to additional steps which may follow the steps of the method in claim 14. The use of

the dependent form for the definition of such subject-matter would therefore appear appropriate (Rule 6.4 PCT).

- 6). The available prior art does not appear to deprive of novelty and/or inventive step the subject-matter of the present invention.

concerning section VII (certain defects)

The description is not in conformity with the current claims as required by Rule 5.1(a)(iii) PCT.

For example, the description on page 8, line 21 to page 16, line 29 and page 17, line 1-25 still recites the wording of claims 1 to 47 as originally filed leading to an inconsistency between claims and description.

Contrary to the requirements of Rule 5.1(a)(ii) PCT, the relevant background art disclosed in the documents D1 and D2 is not mentioned in the description, nor are these documents identified therein.



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